Claim Rejections – 35 USC 112

Re: OA Numbers 10 and 11:

Please amend Claim 16 to read as follows:

16. The system of claim 1, further comprising means for displaying available benefits applicable to said data, said available benefits listed in a manner selected from the group consisting of benefit class or category, value of benefits, cost (if any) of benefits, importance of benefits, relevance of benefits, ease of use of benefits, expiration (date) of benefits, creation (date) of benefits, type of benefits, and physical proximity of said entity to one or more said benefit providers.

Technical changes made; Claim 16 is now definite and particularly points out and distinctly claims the subject matter which applicant regards as the invention.

Re: OA Numbers 10 and 12:

Please amend Claim 54 to read as follows:

54. The system of claim 1, further comprising:

without leaving system, means for connecting said entity with at least one of said plurality of benefit providers directly via said system; and

means for said entity to interact with said benefit providers via said system; and

means for said benefit providers to offer said benefits to said entity via said system; and

means for completion of application forms, when applicable, by said entity via said system; and

means for transmitting said benefit approval for said entity by said benefit providers via said system; and

means for transmitting an acceptance of said benefits by said entity via said system; and

means for receiving said benefits by said entity via system; and

means for using said benefits by said entity via system.

Technical changes made; Claim 54 is now definite and particularly points out and distinctly claims the subject matter which applicant regards as the invention.

Please amend Claim 138 to read as follows:

138. The method of claim 87, further comprising the step, without leaving said system, of connecting said entity with at least one of said plurality of benefit providers via said system; and

comprising the step of said entity interacting with said benefit providers via said system; and

comprising the step of said benefit providers offering said benefits to said entity via said system; and

comprising the step of completing said application forms, when applicable, by said entity via said system; and

comprising the step of transmitting said benefit approval for said entity by said benefit providers via said system; and

comprising the step of receiving said benefits by said entity via system.

Technical changes made: Claim 138 is now definite and particularly points out and distinctly claims the subject matter which applicant regards as the invention.

Re: OA Numbers 10 and 13:

As the above amended claims 16, 54, and 138 now comply with 35 U.S.C. 112; claims 17, 55, and 139 are no longer dependent on rejected claims.

Accordingly, applicant submits that claims 16-17, 54-55, and 138-139 are now allowable and solicits reconsideration and allowance.

Claim Rejections – 35 USC 102

The Reference and Differences of the Present Invention Thereover

Prior to discussing the remaining claims, applicant will first discuss the College Board reference and both the general novelty of the present invention and its unobviousness (addressing both 35 USC 102 and 103) over the reference. This discussion is also intended to cover and address any and all other "scholarship/educational financial aid/educational benefit" matching system/method(s) which may have existed prior to applicant's priority date(s) anywhere in the world.

College Board (www.collegeboard.com, Screen Print, 1/25/1999) is *non-patent* prior art. The inherent problem with such art is that because it is not a patent, it is by its very nature materially and measurably less detailed and exact than patents. This is especially so when dealing with unpatented business systems/methods; where determining just how a given system/method works and how it doesn't; what's included and what's not; what it does and what it doesn't; and what it is and what it is not is often difficult and open to differing and various findings, interpretations, and conclusions.

Unlike such problematic non-patent (prior) art, however, patents have a large number of specific, detailed and exacting legal/statutory requirements. All of a patent's many varied aspects are readily available and known. This wide disparity between patent and non-patent prior art makes it relatively easy—*too easy*—to make it appear, at least initially, that some to as many of all of any given invention's claims have been anticipated by some non-patent prior art somewhere.

Such is the case with College Board (Re OA page 4, # 15); where claims 1, 16-21, 25-27, 46-50, 54, 55, 58-62, 64-74, 77-87, 101-106, 110-112, 131-134, 138, 139, 142-146, 148-158, 161-164, 166-169, and 171-180 are rejected as being anticipated by College Board.

As will be seen, these claims only *appear* to have been anticipated by College Board.

College Board makes clear that their system/method is for the express and limited *single* purpose of matching individuals only with " . . . *scholarships, loans, internships, and other financial aid programs from non-college sources* . . ." (from page 2 of the 1/25/1999 screen print reference). Note also the even further negatively recited limitation of the College Board's educational class/category of benefits as being required to be only from " . . . *non-college sources* . . .." In fact, the next sentence of reference goes on to clarify what their system/method *really is* and what individuals *actually* received when they used their system/method, namely (and only) " . . . *potential scholarship opportunities* . . .." Note also in the following paragraph that College Board's system/method is called—appropriate given its stated purpose—"*Scholarship Search;*"

and that Scholarship Search's information is derived from *"The Scholarship Search Handbook."* Demonstrating that College Board/Scholarship Search is a *limited* benefit-matching system.

Applicant's method/system (as is clear from the specification), on the other hand, is novel and distinguishes over this reference by having no such limits in either the classes/categories or the types of benefits which may optionally be made available to entities. One has only to visit the GovBenefits.com and BenefitsCheckUp.org (BCU) web sites to fully appreciate the functional differences between them and Scholarship Search. As would be clear given both its stated purpose and actual operation; were the College Board system/method to have been backed by a patent; such a patent would have taught no better than how to match *educational* class/category *non-college* benefits with *individuals* seeking such educational class/category benefits. Unfortunately (and though applicant wishes it did exist), neither College Board nor any other company, individual, or organization apparently had the foresight to patent such a scholarship-matching business method; limited in its use and value relative to the present invention though it would be. Such a limited patent would—were it in existence--clearly, convincingly, and obviously not anticipate nor make obvious the present invention.

Operational (Method) Difference (35 USC 102)

Specifically, the present invention recites and teaches, " . . . *of a variety* (of available benefits) . . . ". "Variety" is defined in the American Heritage Dictionary as meaning: 1. *The condition or quality of being various or varied; diversity.* 2. *The number or collection of different things; assortment.* 3. *Something that is distinguished from other things by a specific characteristic or set of characteristics.*

Strongly supported by the above definition of "variety" and the present invention's specification as to its intended meaning, this word's use in claims 1 and 87 refers *not* to (just) a (potentially) large number of benefits; but instead to a wide range of *diverse* benefits. This is a critically important distinction. College Board limits their benefits only to scholarships & other educationally-related benefits. Accordingly, no reasonable ("reasonable man") definition of "variety" would allow for, permit, or justify the *specifically-limited-class/category* College Board system/method as anticipating the present invention.

The differences between a limited class/category benefit-matching system/method like College Board and the present invention are much more than merely a case where one "set" of benefits is substituted for another. No; for by being unlimited in what benefit classes/categories (and therefore the benefits themselves) the present invention may offer (as seen with GovBenefits and BCU), it teaches and provides for a different *value* and *range* than what College Board teaches; which under 35 USC 102 clearly demonstrates and satisfies the novelty requirement.

The following #'s A through G also point out and readily support that the present invention is both novel and non-obvious. They are directed to and intended to address any and all 35/102 and/or 103 objections/rejections contained within the OA:

A. Unexpected Results: The results achieved by the invention are new, unexpected, disproportionate, and superior, as follows:

New: The present invention is the first system/method ever to provide a practical and economically feasible system for matching a wide range of benefit-seeking entities with a wide range of diverse benefits made available from up to virtually any number of benefit providers.

Unexpected: The present invention unexpectedly delivers a plethora of varied class/category benefits; something no one expected could be done until the launching of the infringing Benefits Check Up and GovBenefits system/methods.

Disproportionate: The aggregation of so many varied benefits in one place at one time for the benefit of so many produces a compelling "benefit-compounding" effect which produces disproportionate positive results for both the entities and the benefit providers.

Superior: As detailed in the specification and elsewhere in this Amendment, because it's able to help far more people far more often and in far more ways than limited systems like College Board's Scholarship Search, the results provided by the present invention are far and away superior to any and all previous benefit-matching methodologies; Internet-based or not.

B. Commercial Success: Two system/methods which are infringing on applicant's invention have quickly achieved dramatic nationwide success. As noted in applicant's

previously approved Petition to Make Special, Benefits Check Up (benefitscheckup.org), launched in June of 2001 and run by the National Council On the Aging (NCOA); and GovBenefits (govbenefits.gov), launched in April of 2002 and run by the United States Department of Labor, are both—according to both media reports and at their respective web sites (ncoa.org in the case of BenefitsCheckUp)--already *each* receive over 100,000 system users/visitors every month. Their quick, phenomenal successes powerfully demonstrates and proves the value of the novel and unobvious features of the present invention.

C. Lack of Implementation: If the invention were in fact anticipated and/or obvious; because of its many advantages, those skilled in the art surely would have implemented it before the present invention's 4/12/2000 PPA priority date. According to the reference (and other non-patent OA references not applied), though the College Board method/system has existed in some form since the mid to late 1990's, it wasn't until the June, 2001 launch of the Benefits Check Up infringing service by the NCOA that applicant's method/system was brought to the marketplace. That's over at least three years of time; which, given the explosive growth of Internet-based and other business system/methods during this time--*including many 100's (1,000's?) of business-method patent filings*--clearly and unequivocally proves that the present invention was neither anticipated nor obvious.

D. Solution of Long-Felt and Unsolved Need: The invention solves a long-felt, long-existing, but unsolved need. As explained and detailed in the present invention's specification, the need for a quick, easy, and accurate way to match benefit-seeking entities with the myriad of classes and types of benefits for which they (may) qualify for has been a painful, unmet need for many, many years; stretching back in the U.S. even to the advent of government-provided social welfare programs in the 1930's. Applicant's invention now quickly and easily solves this dilemma.

E. Competitive Recognition: As noted above, the invention has been (unknowingly) copied by at least two different infringers—the National Council on the Aging (NCOA) and the U.S. Department of Labor. Moreover, James Firman, the President of NCOA, has made a number of statements to the media and via their website (ncoa.org) indicating that

BenefitsCheckUp was the first web-based service ever to offer a wide range of benefits to those who are (or may be) qualified to receive them (in NCOA's case, "senior" citizens).

F. New Principle of Operation: Instead of following a well-worn trail looking for incremental improvements in what already existed, the present invention utilizes a new "*unlimited* benefit class/category aggregation and dissemination " principle of operation to blaze an exciting new trail to create a benefit-matching system/method unlike anything that ever existed before.

G. Solved Different Problem: Applicant's invention solves a different problem than the reference (College Board); and such different problem is recited in the patent/claims. *In re Wright, 6 USPQ 2d 1959 (1988).* Unlike College Board, which only helps solve the relatively small problem of locating scholarships and the like for individuals, the present invention helps solve the nationally endemic and far different problem of matching individuals—and other types of entities as well--with up to a virtually unlimited number and variety of diverse class/category benefits being offered by a multitude of benefit providers.

The Rejection of Claims 1 and 87 is Overcome

Though applicant submits that—for the reasons cited above—claims 1 and 87 are clearly not anticipated by College Board even as *originally* written; applicant nevertheless wishes to amend claims 1 and 87 to *even more clearly* recite the present invention's novel subject matter and define patentably over and distinguish from and over this reference, as follows (*specification backed and supported amendments in italics*):

1. A system for permitting an entity to more effectively make use of a variety of available benefits from a plurality of goods, services, information, and value benefit providers, wherein said benefits are offered specifically to those entities qualified/eligible to receive said benefits, said system comprising:

means for storing in a memory in the system entity information, benefit-provider information, and benefit correlation information;

means for inputting into said system a set of entity demographic, geographic, psychographic, and preference data for said entity;

means for inputting into said system benefit information from two or more distinctly different benefit classes/categories;

means for comparing said entity data set to determine those benefit-providers, if any, which have benefits said entity is qualified to utilize;

means for analyzing said benefit-provider information and said benefit correlation information to determine whether any benefit-providers are offering potentially applicable benefits for said data and whether said data satisfies requirements for obtaining said potentially applicable benefits;

means for displaying a message to inform a system user of any available benefits applicable to said data;

wherein said *variety of* benefits includes at least one of a discounted rate or value available to the entity as a result of entity's qualifying or being eligible for at least one benefit available from at least one benefit provider;

wherein said system is unlimited in the number of distinctly different benefit classes/categories it may offer said entity.

87. In a system, a method for permitting an entity to more effectively make use of a variety of available benefits from a plurality of goods, services, information, and value benefit providers, wherein said benefits are offered specifically to those entities meeting the qualifications/eligibility requirements of one or more benefit providers, said method comprising:

storing in a memory in the system entity information, benefit provider information, and benefit correlation information;

inputting a set of entity demographic, geographic, psychographic, and preference data for said entity into said computer system by means of a data entry device electronically communicating with said system;

inputting into said system benefit information from two or more distinctly different benefit classes/categories;

operating the computer system to compare said entity data information to determine those benefit providers, if any, which have benefits entity is qualified to utilize;

further operating said system to determine whether any benefit provider is offering a benefit applicable to said data;

displaying a message to inform a system user of any available benefits applicable to said data;

wherein said *variety of* benefits includes at least one of a discounted rate or any other value available to entity as a result of entity's qualifying for/being eligible for at least one benefit from at least one benefit provider.

wherein said system is unlimited in the number of distinctly different benefit classes/categories it may offer.

The addition of the "unlimited/two or more" matter to each of the now rewritten claims 1 and 87 does now clearly distinguish over College Board under Section 102 as a result of the above discussion (including #'s A through F). It does so by providing—unlike College Board's "Scholarship Search" system--an up to *unlimited* number of different class/category benefits to entities, providing for a *wide variety of related and unrelated* benefits. Hence, because all the physical (method) characteristics of the present invention are not contained in a single prior art reference, under Section 102, the present invention is novel. Applicant accordingly requests reconsideration of the rejection of now amended claims 1 and 87.

Note that the present invention could also easily demonstrate novelty by being shown to be operating in a different mode than College Board. In fact—even if the present invention *wasn't* novel over College Board--the applicant's system/method would still obviously and convincingly satisfy the novelty requirement by being shown to be a *new use* of an old process (per 35 USC 102 and 100[b]); for the many applicable and justifiable reasons given in the preceding comments, elsewhere in this amendment, and in the present invention's specification. There's clearly now no question either of the present invention's novelty or its unobviousness.

The Dependent Claims are A Fortiori Patentable Over College Board

1. (35 USC 112) amended dependent claim 16 and dependent claim 101 (Re OA numbers 15 & 17) incorporate all the subject matter of amended claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.
2. Dependent claims 17 and 102 (Re OA numbers 15 & 18) incorporate all the subject matter of amended claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 17 and 102.
3. Dependent claims 18 and 103 (Re OA numbers 15 & 19) incorporate all the subject matter of amended claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.
4. Dependent claims 19 and 104 (Re OA numbers 15 & 19) incorporate all the subject matter of claims 18 and 103 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 19 and 104, to wit: "some portion of".
5. Dependent claims 20 and 21; 105 and 106; (Re OA numbers 15 & 20) incorporate all the subject matter of claims 1 and 20; 87 and 105; respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 20, 21, 105, and 106.
6. Dependent claims 25 and 110 (Re OA numbers 15 & 21) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.
7. Dependent claims 26 and 111 (Re OA numbers 15 & 22) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 26 and 111.
8. Dependent claims 27 and 112 (Re OA numbers 15 & 23) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently

patentable over this reference. Additionally, specific and relevant support could not be found in reference for OA's position on claims 27 and 112.

9. Dependent claims 27 and 112 (Re OA numbers 15 & 23) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 27 and 112.

10. Dependent claims 46 and 131 (Re OA numbers 15 & 24) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.

11. Dependent claims 47 and 132 (Re OA numbers 15 & 25) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.

12. Dependent claim 48 (Re OA numbers 15 & 26) incorporates all the subject matter of claim 1; which makes it a fortiori and independently patentable over this reference.

13. Dependent claims 49 and 133 (Re OA numbers 15 & 27) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.

14. Dependent claims 50 and 134 (Re OA numbers 15 & 28) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 50 and 134.

15. (35 USC 112) amended dependent claims 54 and 138 (Re OA numbers 15 & 29) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 54 and 138.

16. Dependent claims 55 and 139 (Re OA numbers 15 & 30) incorporate all the subject matter of claims 54 and 138 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 55 and 139.

17. Dependent claims 58 and 142 (Re OA numbers 15 & 31) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently

patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 58 and 142.

18. Dependent claims 59 and 143 (Re OA numbers 15 & 32) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 59 and 143.

19. Dependent claims 60 and 144 (Re OA numbers 15 & 33) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 60 and 144.

20. Dependent claims 61 and 145 (Re OA numbers 15 & 34) incorporate all the subject matter of claims 60 and 144 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 61 and 145.

21. Dependent claims 62 and 146 (Re OA numbers 15 & 35) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.

22. Dependent claims 64 and 148 (Re OA numbers 15 & 36) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 64 and 148.

23. Dependent claims 65 and 149 (Re OA numbers 15 & 37) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 65 and 149.

24. Dependent claims 66 and 150 (Re OA numbers 15 & 38) incorporate all the subject matter of claims 1 and 149 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 66 and 150.

25. Dependent claims 67 and 151 (Re OA numbers 15 & 39) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.

26. Dependent claims 68 and 152 (Re OA numbers 15 & 40) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.

27. Dependent claims 65 and 149 (Re OA numbers 15 & 37) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 65 and 149.

28. Dependent claims 69 and 70; 153 and 154; (Re OA numbers 15 & 41) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference.

29. Dependent claims 71 and 72; 155 and 156 (Re OA numbers 15; 42 & 43) incorporate all the subject matter of claims 1; 87 respectively; which makes them a fortiori and independently patentable over this reference.

30. Dependent claims 73 and 74; 157 and 158 (Re OA numbers 15; 44 & 45) incorporate all the subject matter of claims 1and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 73, 74, 157, and 158.

31. Dependent claims 77 and 161 (Re OA numbers 15 & 46) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 77 and 161.

32. Dependent claims 78 and 162 (Re OA numbers 15 & 47) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 78 and 162.

33. Dependent claims 79 and 163 (Re OA numbers 15 & 48) incorporate all the subject matter of claims 1 and 87 respectively; which makes them a fortiori and independently

patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 79 and 163.

34. Dependent claim 83 (Re OA numbers 15 & 51) incorporates all the subject matter of claim 1; which makes it a fortiori and independently patentable over this reference.

35. Dependent claim 84 (Re OA numbers 15 & 52) incorporates all the subject matter of claim 1; which makes it a fortiori and independently patentable over this reference.

36. Dependent claim 85 (Re OA numbers 15 & 53) incorporates all the subject matter of claim 1; which makes it a fortiori and independently patentable over this reference.

37. Dependent claim 86 (Re OA numbers 15 & 54) incorporates all the subject matter of claim 1; which makes it a fortiori and independently patentable over this reference.

38. Dependent claim 177 (Re OA numbers 15 & 62) incorporates all the subject matter of claim 87; which makes it a fortiori and independently patentable over this reference.

39. Dependent claim 178 (Re OA numbers 15 & 63) incorporates all the subject matter of claim 87; which makes it a fortiori and independently patentable over this reference.

40. Dependent claim 179 (Re OA numbers 15 & 64) incorporates all the subject matter of claim 87; which makes it a fortiori and independently patentable over this reference.

41. Dependent claim 180 (Re OA numbers 15 & 65) incorporates all the subject matter of claim 87; which makes it a fortiori and independently patentable over this reference.

The Rejection of Claims 80, 81, 82, 164, 169, and 176 is Overcome

In a similar manner, with the same reasons, and with the same justified support as with independent claims 1 and 87, above, applicant wishes to amend claims 80, 81, 82, 164, 169, and 176 to more clearly recite the present invention's novel subject matter and define patentably over and distinguish from and over this reference. For the sake of time, space, and ease of review, only the changed subject matter (in italics) of each of the amended claims will be shown here. The complete amended claims are shown in the referenced Appendix.

Claim 80 (OA #49)**:**

" . . . relating to a plurality of benefits *from at least two distinctly different benefit classes/categories*; . . ."

Claim 81 (OA #50)**:**

" . . . relating to a plurality of benefits *from at least two distinctly different benefit classes/categories*; . . ."

Claim 82 (OA #49):

" . . . relating to a plurality of benefits *from at least two distinctly different benefit classes/categories*; . . ."

Claim 164 (OA #55):

" . . . a central benefit information storage system *containing at least two distinctly different benefit classes/categories* to determine if any . . ."

Claim 169 (OA #55):

" . . . creating a benefit listing *containing at least two distinctly different benefit classes/categories; . . .*"

Claim 176 (OA #61):

" . . . viewing, using a computer, benefit information *from at least two distinctly different benefit classes/categories; . . .*"

The Dependent Claims are A Fortiori Patentable Over College Board

42. Dependent claims 166 and 171 (Re OA numbers 15 & 56) incorporate all the subject matter of claims 164 and 169 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 166 and 171.

43. Dependent claims 167 and 173 (Re OA numbers 15 & 57) incorporate all the subject matter of claims 166 and 168 respectively; which makes them a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claims 167 and 173.

44. Dependent claim 174 (Re OA numbers 15 & 59) incorporates all the subject matter of claim 169; which makes it a fortiori and independently patentable over this reference. Additionally, specific and relevant support could not be found in reference for the rejection of claim 174.

45. Dependent claim 175 (Re OA numbers 15 & 60) incorporates all the subject matter of claim 169; which makes it a fortiori and independently patentable over this reference.

Additionally, specific and relevant support could not be found in reference for the rejection of claim 175.

Claims Rejection – 35 USC 103

In addition to the previously detailed information in support of the novelty and unobviousness of the present invention beginning on page 4 of this Amendment (including #'s A-G), applicant submits the following information which also overcomes the obviousness objections/rejections in the OA of claims 22-24, 29, 51-52, 107-109, 114, and 135-136.

The Rejection of Claims 22-24 and 107-109 is Overcome

(Re: OA numbers 67, 68, 69, & 70)

As can be seen from the reference, College Board's EXPAN system, unlike their Scholarship Search system, is a combination online/offline system which is not web based. To use EXPAN requires a personal meeting with a counselor or other school official to complete the requisite questionnaire; or the taking home of a disk to do the same thing. The information is then either mailed in or transmitted—apparently over phone lines to a BBS--via the use of proprietary software. While automated e-mail systems were well know at the time of the present invention; it would be impossible for those skilled in the art to combine the updated-only-once-a-year EXPAN with time-sensitive e-mail. Even if a way to combine these two references were found, the result would be an inoperative and/or virtually worthless combination; clearly unable to match the quick and easy benefit notifications readily taught by and available from the invention.

Thus applicant submits that the invention is much more that merely a combination of EXPAN and e-mail and that—under 35 USC 103--claims 22-24 and 107-109 clearly recite novel physical (method) subject matter which distinguishes over any possible combination of EXPAN and e-mail. Applicant accordingly requests reconsideration of the rejection of these claims.

The Rejection of Claims 29 and 114 is Overcome

(Re: OA numbers 67, 71, and 72)

The meaning and intent of claims 29 and 114 is to require more than just the *optional* updating of a given profile in order to maintain accuracy of the results for the entity's benefit. Under 29 & 114, it is an actual *requirement* that an entity update the profile as determined by the system operator and/or one or more of the benefit providers; or the entity will not be able to use the system at all. The threat of being cut off from any use of the system is intended to be a/the driver to maintain the continued greatest accuracy and integrity possible of the data. This is the "stick" part of the "carrot and the stick" approach of insuring compliance with the system operational requirements and procedures. EXPAN does not teach this; and no other specific reference is note in the OA.

Thus applicant submits that the invention is much more that merely a combination of EXPAN and optional/for the entity's benefit data updating; and that--under 35 USC 103--claims 29 and 114 clearly recite novel physical (method) distinguishing subject matter. Applicant accordingly requests reconsideration of the rejection of these claims.

The Rejection of Claims 51 & 52; 135 & 136 is Overcome

(Re: OA numbers 67, 76, 77, and 78)

While it's true that links predate the invention; using them to access any required benefit provider application forms can at times be surprisingly problematic. Links are often known to "break;" directing visitors to either no site, the wrong location in often 100+page benefit-provider web sites, or to wrong sites entirely. Also, while much of the OA directs itself to College Board; as is made clear in the present invention's specification and this amendment, many of the invention's potential benefit providers may choose to keep their identity hidden from various benefit-seeking entities. Unlike with links to benefit provider forms found at the providers' own websites, application forms made available instead as part of the benefit search results would maintain this confidentiality.

Second, as stated previously, College Board's EXPAN system, unlike their Scholarship Search system, is a combination online/offline system which is not web based. To use

EXPAN requires a personal meeting with a counselor or other school official to complete the requisite questionnaire; or the taking home of a disk to do the same thing. The information is then either mailed in or transmitted—apparently over phone lines to a BBS--via the use of proprietary software. Trying to use such a system to obtain timely help in completing sometimes very complicated application forms would be unwieldy in the least; impossible in the worst.

Therefore, the result of the present invention's superior ability to more quickly and easily—and, when needed/desired—*privately and confidentially*--provide the actual application forms and assistance in completing them produces new, valuable, exciting, and unexpected results.

Thus applicant submits that the invention is much more that merely a combination of EXPAN and links; and that--under 35 USC 103--claims 51, 52, 135, and 136 clearly recite novel physical (method) distinguishing subject matter. Applicant accordingly requests reconsideration of the rejection of these claims.

The Rejection of Claims 30, 34-36, 41-43; and 115, 119-121, 126-128 is Overcome

(Re OA numbers 67, 73, AND numbers 79, 89, 90, and 91)

Claims 30, 34-36, 41-43 AND 115, 119-121, 126-128 are cancelled and replaced by NEW claims 30 AND 115, respectively, as follows (repeated in Appendix):

30. The system of claim 1, further comprising means for said entity and/or said benefit provider to pay for said system access and use via one or more methods from the group of: on a per benefit disclosed basis; on a per benefit received basis; on a per benefit utilized basis; through said entity's relinquishment of at least a portion of at least one of said benefits; through the payment of some percentage of at least one of said benefits; through the payment from a plurality of at least part of a value equivalent of at least one of said benefits.

115. The method of claim 87, further comprising the step of said entity's and/or said benefit provider's paying for said system access and use via one or more methods from the group of: on a per benefit disclosed basis; on a per benefit received basis; on a per benefit utilized basis; through said entity's relinquishment of at least a portion of at least one of said benefits; through said entity's payment of some percentage of at least one of

the said benefits; through said entity's payment from at least part of a value from a plurality of value equivalents corresponding to at least one of said benefits.

As noted in the OA, while web-commerce (internet payment systems) were well known by the time invention was made, never before have the income-generation methods disclosed in new claims 30 and 115 ever existed. Now--for the first time ever--a benefit-matching system doesn't have to be advertisement-based or fee-based (or rely on tax dollars like the GovBeneifts service does, or on contributions, as the Benefits Check Up service does [now also adding other income-generating systems to their service). Instead, *the benefits themselves* can supply the revenue needs of the system; freeing the system/company from investing what often proves to be large—sometimes crippling—expenditures in time, effort, and money to build an advertising-supported system. Just as difficult is trying to get people and other entities to pay for the use of such a system before they see if the benefit information/ benefits they receive even make it worth the cost. As has been amply and repeatedly reported in the media since the dawn of web-based payment systems, precious few web-based companies have been able to make the subscription model work. Most companies trying to use subscriptions quickly lose up to millions of dollars, find themselves drowning in debt, and go out of business.
Basically, the invention can be set up as a "pay-only-for-results" system/method. If a person/entity actually qualifies for and is able to obtain one or more benefits, they share some portion of what they receive with the system operator; if not, the entity has incurred no costs of any type for using the system. Most people love paying only for results when such an option is made available to them. Such new, valuable, and unexpected results are clearly superior to what has existed before.
Additionally, it is submitted that the specific recitations of various payment/income options for the invention within the specification does provide the necessary and required support for new claims 30 & 115: "*FIG. 3 is a flow chart . . . Further, central controller 200 charges user's credit or debit card and updates billing information in the user information database 200 to reflect the "purchase" (transmission) of requested benefit information. It is to be understood that numerous other alternative charging/billing and income-generation methods may be used without detracting from the scope of the present*

invention . . . per benefit received, a percentage of benefit(s) utilized . . . per benefit viewed, per benefit utilized basis, . . . " from page 13/*Detailed Description of the Invention.*

While it's true that the benefit matching system/method would work regardless of how the entity paid for system access and use; as *dependent* claims, an exciting new and improved set of payment/income methods could be used to produce valuable new and unexpected results (including no subscription fees for entity use of system, lower system operational costs, and advertising difficulties). The entities, the benefit providers, and even the system (operator) itself would all benefit.

As can now be seen, the unique and non-obvious payment/income methods of new claims 30 and 115 *are* functionally involved in the steps recited; having both functional manifestation and novel relation to the invention's structure and operation and making them patentable over College Board and allowable under 103. Therefore, In re Gulack and In re Lowry do not apply to (the subject matter in) new claims 30 and 115.

Given these facts, applicant accordingly requests reconsideration of the rejection of the subject matter now found in these new claims.

Remarks—General

By the above amendment, applicant has amended the title to further emphasize the novelty of the invention; while canceling/amending/rewriting various of the claims to define the invention more particularly and distinctly so as to overcome the technical rejections/objections and define the invention patentably over the prior art.

Non-Applied References

Cited but non-applied references in the OA have been reviewed and they neither show applicant's invention nor render it obvious. Please note that applicant's invention appears to predate Hinkey et al due to an earlier provisional patent application date.

Conclusion

For all the reasons given above, applicant respectfully submits that the claims comply with Section 112; the claims define over the prior art under Section 102; and the claimed distinctions are of patentable merit under Section 103 because of the new results provided. Accordingly, applicant submits that this application in now in condition for allowance, which action applicant respectfully solicits.

Conditional Request for Constructive Assistance

Applicant has rewritten the abstract and amended/rewritten the claims of this application so that they are proper, definite, and define novel structure which is also unobvious. If for any reason this application is not believed to be in full condition for allowance, the pro se applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to MPEP 2173.02 and 707.07 (j) (and/or other) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very respectfully,

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Attachment: Appendix to Amendment A